

Application No. 10/085,731  
Amendment dated January 21, 2005  
Reply to Office Action of July 21, 2004

### **REMARKS**

Applicant amended claims 1, 5, 29, 31, 40, 65, 89, and 97, and added new claims 166-171 to further define Applicant's invention. Claims 166-171 read on Group I as defined by the Restriction Requirement dated December 31, 2003.

In the Office Action, the Examiner objected to claims 1-61 because of minor informalities. Applicant amended claims 1, 5, 29, and 40 as suggested by the Examiner. Applicant submits that the Examiner's objections have been overcome.

The Examiner rejected claims 1-4, 6, 7-11, 13, 16, 19, 20, 23, 24, 33-40, 44, 45, 51-53, 65-68, 70-73, 75, 79, 80, 83, 84, 92-97, 101, 102, and 108-110 under 35 U.S.C. § 102(e) as being anticipated by U.S. Publication No. 2003/0135220 to Cauthen ("Cauthen"). Independent claims 1 and 65, as now amended, recite a guard with at least one disc space penetrating extension having first and second portions that each include a contact surface, "said contact surfaces of said first and second portions being pivotal about an axis that passes through at least a portion of the pathway to the disc space and the adjacent vertebral bodies."

Cauthen teaches an insertion instrument 10 having a pair of guides 16, 20 that pivot about articulating hinge 22. (Cauthen, page 2, paragraphs 33-34; Figs. 1-2). Guides 16, 20 pivot about an axis that lies outside the pathway leading to the disc space and adjacent vertebral bodies. (See, e.g., Cauthen, Figs. 1-2). Cauthen does not teach or suggest a guard as recited in independent claims 1 and 65.

The Examiner rejected claims 5, 12, 14, 21, 41-43, 50, 69, 74, 76, 81, 98-100, and 107 under 35 U.S.C. § 103(a) as being unpatentable over Cauthen; rejected claims 46-49 and 103-106 under 35 U.S.C. § 103(a) as being unpatentable over Cauthen in view of U.S. Patent No. 5,015,255 to Kuslich et al.; rejected claims 54-62, 64, 111-119, and 121 under 35 U.S.C. § 103(a) as being unpatentable over Cauthen in view of U.S. Publication No. 2004/0073309 to Bianchi et al.; and rejected claims 63 and 120 under 35 U.S.C. § 103(a) as being unpatentable over Cauthen and Bianchi, further in view of U.S. Publication No. 2003/0023209 to Gruskin et al. Applicant submits that the rejections over claims 5, 12, 14, 21, 41-43, 46-50, 54-64, 69, 74, 76, 81, 98-100, 103-107, and 111-121 are rendered moot at least because they depend from an

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allowable independent claim, or claims dependent therefrom.

The Examiner provisionally rejected claims 1-37, 39, 40, 43-45, 50-67, 72, 77-94, 96, 97, 99-102, and 108-121 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-15, 18-64 70, 77-100, and 102-115 of Application No. 10/085,731. Applicant respectfully traverses the Examiner's provisional obvious-type double patenting rejection. The serial number of the reference which the Examiner is using to provisionally reject the present claims is the serial number of the present application. Accordingly, Applicant submits that the provisional rejection is improper and must be withdrawn.

Applicant submits that independent claims 1 and 65 are patentable and that dependent claims 2-64, 66-121, and 166-171 dependent from one of independent claims 1 and 65, or claims dependent therefrom, are patentable at least due to their dependency from an allowable independent claim.


In view of the foregoing remarks, it is respectfully submitted that the claims, as amended, are patentable. Therefore, it is requested that the Examiner reconsider the outstanding rejections in view of the preceding comments. Issuance of a timely Notice of Allowance of the claims is earnestly solicited.

To the extent any extension of time under 37 C.F.R. § 1.136 is required to obtain entry of this reply, such extension is hereby respectfully requested. If there are any fees due under 37 C.F.R. §§ 1.16 or 1.17 which are not enclosed herewith, including any fees required for an extension of time under 37 C.F.R. § 1.136, please charge such fees to our Deposit Account No. 50-1066.

Respectfully submitted,

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